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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,074	03/13/2001	Stephen Johnson	TPP31729	9099
33942	7590	09/23/2009		
CHA & REITER, LLC 210 ROUTE 4 EAST STE 103 PARAMUS, NJ 07652			EXAMINER SIDDIQI, MOHAMMAD A	
			ART UNIT	PAPER NUMBER
			2454	
			MAIL DATE	DELIVERY MODE
			09/23/2009	PAPER

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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 *Ex parte* STEPHEN JOHNSON and CECIL V. HORNBAKER, III
11

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13 Appeal 2009-000470
14 Application 09/804,074
15 Technology Center 2400
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18 Oral Hearing Held: May 21, 2009
19

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21 Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and MARC S.
22 HOFF, *Administrative Patent Judges*.
23

24 ON BEHALF OF THE APPELLANTS:
25

26 STEPHEN GIGANTE, ESQ.
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31 The above-entitled matter came on for hearing on Thursday,
32 May 21, 2009, commencing at 9:00 a.m., at the U.S. Patent and Trademark
33 Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery,
34 Notary Public.

1 USHER: Good morning. Calendar Number 52, Mr. Gigante.

2 MR. GIGANTE: Good morning, Your Honors. Would you like me to
3 start with a brief explanation of the invention?

4 JUDGE HAIRSTON: It's your show, however you want to present it.

5 MR. GIGANTE: The invention is a system and process for network
6 collaboration through embedded annotation and rendering instructions. What
7 that means is that this is a tool by which users that have thin client devices,
8 that don't have processing power capable of downloading certain application
9 software, can modify a document and collaborate amongst other users
10 through the use of the web browser and the scripting language.

11 It has advantages in that you don't require plug ins, which many times
12 for security purposes you may not be able to download in certain systems;
13 and what it enables you to do is preserve the basic document, yet allow
14 someone with a small device, such as a PDA -- a cell phone nowadays -- to
15 be able to look at the document and, by the use of the scripting tool, be able
16 to make additions to it.

17 But, in essence, they're not actually modifying the document itself.
18 What they're doing is when they use the scripting tool the URL of the
19 document -- the Uniform Resource Locator -- takes the location of the
20 document, and then after it strings along the code that represents what you
21 just did.

22 So what this does is it enables you now to -- it's essentially embedded
23 the changes into the URL. By doing this, you can now turn around and
24 appear to modify a document, but in fact you really haven't.

25 What you've done is you've embedded some changes to that, and
26 when it's displayed, you can see the changes.

1 You can then email this link to someone else who is not required to
2 download any application software to view it. All they need is a web
3 browser themselves, and if they have a scripting tool, they can make
4 additional changes as well.

5 As far as the rejections go, the examiner withdrew the 101 rejection to
6 Claim 23; but I believe he's retained the rejection to 17, 43, and 51, I believe
7 it is.

8 As far as the statutory subject matter goes, the appeal brief was
9 written, I think, prior to Bilski coming down; but I feel it complies with
10 Bilski because this is not a software construct per se. This is an invention
11 that requires hardware, and it manipulates hardware.

12 JUDGE HAIRSTON: Where is the hardware in your Claim 17?

13 MR. GIGANTE: The server process. That's a functional limitation
14 that -- the server process in Figure 2, the server 53.

15 The server process receives the collaborative content and the
16 rendering instructions. It sends back to either the originator, who made the
17 initial collaboration, or to a recipient work station, a URL that now has been
18 changed in that they have embedded the changes.

19 JUDGE NAPPI: Claim 17 recites a recipient work station?

20 MR. GIGANTE: No. The server process is one piece of hardware.

21 JUDGE NAPPI: What kind of hardware is it? I look at Claim 21 and
22 23 or 22 says the server process is executed on the computer system, which
23 seems to indicate that the server process would not be the computer system
24 but would be software on the computer system.

25 MR. GIGANTE: Okay. What the difference is on that is -- that could
26 be a case where you have a peer to peer. You could have the originator

1 work station has a server process on it.

2 We do show that as –

3 JUDGE NAPPI: The server process isn't a piece of equipment, it's a
4 piece of software.

5 MR. GIGANTE: No, if a work station has the power, as in Figure 3,
6 there's a server process on there. The server process would be a micro
7 processor and associated memory.

8 So as far as Claim 22 goes, it could be that the originator work station,
9 in fact, has the ability to process the changes.

10 JUDGE HOFF: Counsel, can you provide support for that definition
11 of server process in your definition?

12 MR. GIGANTE: At the moment I see page 13 of the application,
13 Paragraph 47, it's saying:

14 "Server process is executing on a similar computer system" –

15 JUDGE NAPPI: Doesn't that mean the server processing software
16 that's executing?

17 MR. GIGANTE: It's software that is loaded into the server.

18 JUDGE NAPPI: But you claim the server process not the server.

19 MR. HOFF: It's where the server process executes separately on a
20 separate computer system in Paragraph 47. Paragraph 48, the peer to peer
21 model, the server process is executing on the receiver; and 52 on the work
22 stations.

23 MR. GIGANTE: Okay. Server process for receiving -- point taken.

24 The server process is a server loaded with software.

25 Okay, Paragraph 40, page 11: "Execution of sequences of instructions
26 contained in the memory codes of processor 14 to perform the process steps

1 described below; and alternative embodiments hardware wired circuitry may
2 be used in place of, or in combination with, computer software instructions
3 to implement the invention."

4 JUDGE HAIRSTON: That could be a general purpose computer per
5 se.

6 MR. GIGANTE: Okay.

7 JUDGE HOFF: In any case, your argument for Claims 17, 41, and 53
8 is that all of them manipulate hardware or a tangible entity.

9 Do you wish to make any further remarks about what hardware is
10 manipulated? What tangible entity is manipulated in any of these claims?

11 MR. GIGANTE: What's being manipulated is it's retrieving the
12 document, it's rendering the document into HTML with the collaborative
13 changes, and it's transmitting that to the originator client work station.

14 JUDGE HOFF: Right.

15 MR. GIGANTE: Other than that, at the moment I don't have anything
16 to add in that regard.

17 JUDGE HAIRSTON: Turn to your art rejection.

18 MR. GIGANTE: The art rejection view of Ribette -- Ribette, we feel,
19 does not anticipate or render the claimed invention obvious.

20 Ribette is an invention whereby web pages have further links where
21 you can add notes. Ribette does not disclose that there is embedding in the
22 URL of the actual changes that are performed.

23 JUDGE HOFF: Do any of your claims refer to a URL?

24 MR. GIGANTE: Claim 61.

25 JUDGE HOFF: So stepping back to independent Claim 1, it doesn't
26 require a modification of URL. What is your argument that prevents that

1 claim?

2 MR. GIGANTE: What it does is -- even without the URL, what it
3 does is it embeds the collaborative content into the location of the document
4 identifier -- I'm sorry, into the base document.

5 So you have the base document, and you have a document identifier,
6 and then you have collaborative content that's embedded into the document
7 identifier.

8 JUDGE HOFF: I understand that is recited in, for example, Claim 17
9 as an embedded annotation in the document identifier. However, that
10 language does not appear in Claim 1.

11 So if you could refer to Claim 1 and point out to us the limitations that
12 would not be anticipated with that.

13 MR. GIGANTE: Claim 1 does discuss embedding. The second
14 paragraph down, about the third line: "So as to annotate said base document
15 by embedding at least one annotation and instructions therefore as encoded
16 representation of collaborative content, and forwarding the collaborative
17 content to a server for execution."

18 Claim 1 does say it's embedding the annotation and instructions.

19 JUDGE HOFF: So the note system of Ribette does not amount to an
20 embedded annotation?

21 MR. GIGANTE: No, the note system of Ribette is a link. It's not
22 embedding into the document identifier. What you do is you download the
23 web page, and then there's a link telling you that there are other notes.

24 Then you have to click on a link to look at the other notes. In fact,
25 you need to download the application -- Column 11, I believe said. They
26 give the example of the chef with the menu. So it's a link rather than

1 embedding. By embedding the instructions into the URL, all you do is click
2 on that link, and you see the document and the annotations at the same time.

3 JUDGE HOFF: So does the specification provide a definition of
4 embedding that we could rely on to distinguish your invention from the
5 reference?

6 MR. GIGANTE: Yes, I believe it does. We talk about Figure 5 –

7 JUDGE HOFF: Paragraph 59 or 60?

8 MR. GIGANTE: "The server process 53 interprets commands and
9 data, i.e. rendering instructions," that's Paragraph 58, "embedded in the
10 encoded collaborative content to determine the type, position, other
11 attributes of the collaborative element with respect to the content."

12 In conjunction with Figure 5, which shows collaborative content,
13 along with the document identifier, that's where I would say there's support
14 for the embedding in the URL -- or in the link, I should say.

15 I guess I would also say while the embedding is not disclosed in
16 Ribette, that we also believe it wouldn't be obvious in view of Ribette. It
17 would be patentable because Ribette requires an application to be
18 downloaded to view the notes -- the additional application.

19 It doesn't have the advantages that the claimed invention does,
20 including the ability to use it with thin client devices that aren't able to --
21 don't have the capacity to download certain applications.

22 Do you have any further questions?

23 JUDGE HOFF: No questions.

24 JUDGE HAIRSTON: No, sir.

25 JUDGE NAPPI: No.

26 MR. GIGANTE: Thank you.

1 (Whereupon, the proceeding at 9:21 a.m. was concluded.)